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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,038	03/05/2002	Teemu Puskala	042933/319824	8149
30671 7590 07/14/2009 DITTHAVONG MORI & STEINER, P.C. 918 Prince St. Alexandria, VA 22314				
EXAMINER PIERCE, DAMON JOSEPH				
ART UNIT		PAPER NUMBER		
3714				
MAIL DATE		DELIVERY MODE		
07/14/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/091,038

Applicant(s)

PUSKALA, TEEMU

Examiner

DAMON PIERCE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2008 and 19 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-30, 39-45, 51, 53 and 54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-30, 39-45, 51, 53 and 54 is/are rejected.
- 7) ☒ Claim(s) 52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-846)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, including claims 1-12, 14-30, 39-45, 51, and 53-54 in the reply filed on 6/19/09 is acknowledged. The traversal is on the ground(s) that the search and examination of all of the claims can be made without a serious burden upon the Examiner as evidenced by the prior search and examination conducted in this application. This is not found persuasive because the Examiner will be required to search new classes/subclasses not previously searched in prior office actions.

The requirement is still deemed proper and is therefore made FINAL.

Response to Amendment

2. The examiner acknowledges the amendments of claims filed on 11/04/08 and 6/19/09. Claims 31-38, 46-50, and 55 are withdrawn based on restriction. Currently, claims 1-12, 14-30, 39-45, 51, and 53-54 are pending.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show element "47" of Fig. 1 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the

application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities:
- pg. 15, 3rd parag. states "display 54", which is inconsistent with Fig. 2;
 - pg. 16, 1st parag. states "DVB or DAB" with no further explanation of acronyms
- Appropriate correction is required.

Claim Objections

5. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 53-55 been with no mention of claim 52.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 16, 41, 43-44, 51, and 54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 16, 41, 43-44, 51, and 54, all include the recitation "facilitating provision" or "facilitate provision", which lacks antecedent basis in the original specification, thus is new matter. In addition, the claims also include recitations of "certain content", content-related predefined message", "the content-related predefined message being generated independently of

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the certain content and automatically modified based on an identity of the certain content", all of which is not supported in the original specification, thus is new matter.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 1-12, 14-30, 39-45, 51, and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackintosh et al. (US 6,317,784 B1) in view of Rouse et al. (US 6,983,310 B2).**

Regarding independent claims 1, 16 and 43, the instant application as best understood is an invention that describes a system that transmits predefined messages from one terminal to another terminal via a network.

Regarding claims 1, 16, 41-45, Mackintosh discloses a system for enhancing communication on a wireless network using predefined messages, comprising a service platform running an on-line service, the on-line service for providing a certain content (Fig. 5, Broadcast internet service provider), the service platform comprising:

transmitting means for transmitting the certain content to a user of at least one wireless terminal, referred to by Mackintosh as broadcast material where broadcast material may include music tracks, advertising tracks, etc. (col. 2, line 42-col.3, line 16);
and

providing means for providing along with the transmitted certain content at least one content-related predefined message to the user of the at least one wireless terminal based upon the certain content, the message being generated independently of the certain content and automatically modified based on an identity of the certain content and also being configured to be transmitted from the at least one terminal (in this case, see col. 2, 42-67, which discloses supplemental materials such as images, video clips, data, and advertising information). Also note, Mackintosh discloses the ability to deliver content, i.e. a music track, in combination with a content-related predefined message (col. 3, lines 42-67) to a user terminal via a wireless communication system (col. 24, line 55 - col. 25, line 4). Referring to Fig. 12, the content-related predefined message comprises the information fields "artist", "song", "album" and album cover (field **518**) that are generated independently of the certain content and automatically modified based on an identity of the certain content. These fields are predefined and generated independently of the certain content, as they are displayed to the player irrespective of

the track being played, but are modified to include data pertinent to the track currently being played.

Mackintosh does not specifically disclose the at least one wireless terminal further comprises selecting means for enabling selecting, by the user of said at least one wireless terminal, whether to transmit one or more of the provided at least one content-related predefined messages wirelessly from said at least one wireless terminal, and transmitting means for transmitting, if the user of said at least one wireless terminal selects to transmit one or more of the provided content-related predefined messages, the selected content-related message to at least one address selectable by the user of said at least one wireless terminal. However, Mackintosh does disclose a communications interface "that allows software and data to be transferred between computer system **702** and external devices", wherein this "can be implemented using a wireless medium" including a cellular phone link (col. 24, line 55 - col. 25, line 4). Additionally, Rouse discloses a system for enabling users of wireless devices to send and receive messages and other information (abstract), including content-related predefined messages (col. 3, lines 27-33). Specifically, Rouse discloses selecting means for enabling selecting whether to originally transmit one or more messages from the wireless terminal in col. 9, lines 43-46. That is, phone keys provide the wireless device user with the ability to select a forward option **718**, which enables a user to forward a selected message to a recipient (col. 9, lines 14-35).

Additionally, Rouse discloses transmitting means for wirelessly transmitting at least one message (col. 5, lines 45-48; col. 10, lines 3-24) to at least one address

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selectable by the user of said at least one wireless terminal (col. 9, lines 47-55). The ability to forward messages among cell phone users, e.g. "text messaging", is well known to one of ordinary skill in the art. To implement such a feature in a system such as the one taught by Mackintosh, which contemplates wireless communication capabilities between cellular phones, would have required only routine skill in the art.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Mackintosh and Rouse as Mackintosh discloses the ability to communicate with external devices via a cellular phone link, as discussed above. All of the claimed elements were known, i.e. providing content and content-related predefined messages to a user of a wireless device and the ability to forward messages among users of wireless devices including cellular phones, at the time of the invention and could have been combined by one of ordinary skill in the art in order to produce predictable results.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the broadcasting system of Mackintosh with the user interface configuration of Rouse in order to provide a more user-friendly system, which would attract more users to this system.

Regarding claims 2-4, 17-20, Rouse discloses wherein the at least one address selectable by the user comprises a predetermined address of at least one other wireless terminal (col. 3, lines 38-45; col. 9, lines 47-55).

Regarding claims 5, 21, Rouse discloses the at least one other terminal comprises a wireless terminal (Rouse, col. 3, lines 33-45).

Regarding claims 6, 22, Rouse discloses means for assessing an output capability of said at least one other terminal to receive the predefined message, and means for configuring the predefined message, prior to transmitting the predefined message to the address of the at least one other terminal, so that the output capability of the at least one other terminal to receive the predefined message is taken into consideration (col. 3, lines 46-50; col. 5, lines 6-26).

Regarding claims 7, 23, Mackintosh discloses the providing means comprises a content determining means for determining the content of the online service ("cut number" col. 9, lines 8-34).

Regarding claims 8, 12, 24, 27 Mackintosh discloses said providing means receives a predefined criteria and generates or selects the predefined message based upon the predefined criteria. That is, Mackintosh discloses the cut number provides information relating to the type of cut, i.e. content, including any of music, ad traffic, EJ segments, etc (col. 9, lines 10-25). If the identified content is a music track, the predefined message will contain information fields such as song, album title, etc., as discussed above with respect to claim 1. If the content is an advertisement segment, the predefined message will contain information fields such as company logos, product pictures, etc., (col. 13, lines 16-22), wherein said fields are automatically modified (i.e. filled in) based upon the advertising segment content.

Regarding claims 9,25, Rouse discloses both terminals may be mobile phones (col. 1, lines 16-21).

Regarding claim 10, wherein the at least one wireless terminal comprises a dedicated button to cause the content-related predefined message to be transmitted to the selected address, the "Send" button on any cellular phone acts as a dedicated button to begin a transmission.

Regarding claims 11,26 Rouse discloses an indicator to be displayed to indicate that at least one content-related predefined message is available for selection (col. 8, lines 5-8).

Regarding claims 14,28 Mackintosh discloses the predefined message is stored in and retrieved by the providing means from a storage device in the service platform (Fig. 1).

Regarding claims 15,30, Mackintosh discloses the predefined message comprises at least one of voice, text, sound, an image, a picture and a video (Fig. 12).

Regarding claims 39,40 wherein the on-line service comprises at least one of an Internet web site and a network server providing at least one of an interactive program and streaming audio and/or video (Mackintosh, col. 8, lines 33-65).

Response to Arguments

9. Applicant's arguments filed 11/4/08 have been fully considered but they are not persuasive.

10. Applicant's remarks states that neither Mackintosh nor Rouse discloses the limitation "a content-related predefined message to the terminal, the message being generated independently of the certain content and automatically modified based on an identity of the certain content". However, as best understood the supplemental materials such as images, video clips, data, and advertising information of Mackintosh (see col. 2, 42-67) is interpreted as a message that is generated independently of the broadcast material such as a music track and automatically modified based on the music track being played at the time.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAMON PIERCE whose telephone number is (571)270-1997. The examiner can normally be reached on 8AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry. Suhol/
Supervisory Patent Examiner, Art
Unit 3714

DJP